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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/469,200	12/21/1999	PAUL H. WEIGEL	5820.555	4696
30589	7590	03/24/2004		
DUNLAP, CODDING & ROGERS P.C. PO BOX 16370 OKLAHOMA CITY, OK 73113				
EXAMINER BUGAISKY, GABRIELE E				
ART UNIT		PAPER NUMBER		
1653				

DATE MAILED: 03/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/469,200	<b>Applicant(s)</b> WEIGEL ET AL.	
	<b>Examiner</b> Gabriele E. BUGAISKY	<b>Art Unit</b> 1653	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 60-72 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1, 60-63, 66 and 67 is/are allowed.
- 6) ☒ Claim(s) 68-70 and 72 is/are rejected.
- 7) ☐ Claim(s) 64 and 65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \*    c) ☐ None of:  
         1. ☐ Certified copies of the priority documents have been received.  
         2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
         3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
     \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
     a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                            | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)        | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

The preliminary amendment of 5/29/2003 was not matched with the application prior to the 10/2003 Office Action. That Action is vacated and replaced by this Action.

Claims 1 and 60-72 are under consideration.

#### ***Specification***

The disclosure is objected to because of the following informalities: The specification is not in compliance with 37 C.F.R. 1.821-1.825, as not all sequences are identified by their SEQ ID NO: (e.g., page 80, lines 13-17 of the 12/10/2001 specification).

Appropriate correction is required.

#### ***Claim Objections***

Claims 65 and 70 are objected to because of the following informalities: an “or” should be between “licheniformis” and “Bacillus”. Appropriate correction is required.

Claim 71 is objected to because of the following informalities: “claims” in line 2 should be “claim”. Appropriate correction is required.

Claims 64 and 69 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should refer to other claims in the alternative only. See MPEP § 608.01(n)

Claim 72 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. Further, a

Art Unit: 1653

multiple dependent claim should refer to other claims in the alternative only. See MPEP

§ 608.01(n).

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 68, 69, 70 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 68 is confusing as it recites “the recombinant expression vector of claim 66 (which comprises the nucleic acid segment of SEQ ID NO:1), and “the nucleic acid segment of claim 1” (which encodes the synthase of SEQ ID NO:2). It is not clear whether the nucleic acid segment must comprise SEQ ID NO:1 or merely encode SEQ ID NO:2.

Claim 69 depends, in the alternative, from itself, thus rendering it indefinite.

Claims 70 and 72 are included in this rejection as they depend from claim 69 and do not clarify the ambiguity.

### ***Conclusion***

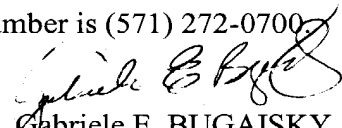
An isolated and purified nucleic acid segment encoding the *S. equisimilis* hyaluronate synthase of SEQ ID NO:2 or comprising SEQ ID NO:1 is deemed free of the prior art, as are constructs containing the nucleic acid.

**Claims 1, 60-63 and 66 -67 are allowed.**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gabriele E. BUGAISKY whose telephone number is (571) 272-0945. The examiner can normally be reached on Tues.- Fri 8:15 AM-1:45 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher SF Low can be reached on (571) 272-0951. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0700.

  
Gabriele E. BUGAISKY  
Primary Examiner  
Art Unit 1653

9 March 2004